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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,500	01/07/2002	Nigel M. Goble	2558-57	4541
23117	7590	11/29/2004		
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714				
			EXAMINER VRETTAKOS, PETER J	
			ART UNIT 3739	PAPER NUMBER

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,500

Applicant(s)

GOBLE, NIGEL M.

Examiner

Peter J Vrettakos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) 1-30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-47 is/are allowed.
- 6) ☒ Claim(s) 31 and 34-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-30 are withdrawn.

Claims 37-47 are allowed (37, 39 and 44 independent).

Claims 31 and 34-36 (31 and 34 independent) are rejected below using newly found art (Eggers et al.).

The instant action is **final**. New art (Eggers) is presented to reject *newly amended* claims 31 and 34.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards ('257) in view of Eggers et al. (5,871,469).

Independent claims 31 and 34

Edwards et al. (Edwards) discloses a method of treating a tumor in a colon (col. 1:52-60; see figure 1) using an electrosurgical system comprising:
an electrosurgical generator (inherent) adapted to generate a radio frequency oscillating voltage output across first and second output terminals;

an electrosurgical instrument (110) having an active tissue treatment electrode (113) connected to the first generator output terminal;

fluid delivery means (117) for delivering electrically-conductive fluid to the tumor to be treated; and

a return electrode (**56 in Eggers; colon treatment – see col. 23:25 in Eggers**) connected to the second generator output terminal,

the method comprising the steps of:

enclosing, in a substantially fluid-tight manner (col. 2:25-35), a space in the colon within which the tumor to be treated is located, and within which at least the active electrode is located (see figure 1);

operating the fluid delivery means at least partly to fill the space with electrically-conductive fluid (col. 4:28-34);

positioning the return electrode within the space (**depicted in Eggers cross-section figure 2b**);

operating the generator to apply a radio frequency voltage between the active and return electrodes (**56 in Eggers**), and completing at least a part of a conduction path between the active and return electrodes using the electrically-conductive fluid;

and manipulating the active electrode (col. 4:54-61) in the vicinity of the tumor to be treated to vaporize the tumor (**vaporization discussed throughout Eggers**).

Claim 34 additional limitation

Edwards also discloses an electrosurgical instrument comprising a shaft (111), and the active (113) and return electrodes (**56 in Eggers**) are located on a distal end of the shaft (see figure 1),

the method further comprising the steps of positioning the proximal end of the shaft to extend out of the space (see figure 1),

and manipulating (131,132) the active electrode by moving the proximal end of the shaft.

Dependent claims

Re: claim 35: Edwards discloses waste matter removal ("aspirating", col. 4:28-34).

Re: claim 36: Edwards discloses use of gas in patented claim 27.

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Edwards in view of Eggers by using a bipolar device for tissue

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vaporization. The motivation would be to remove the need for an external return electrode and to provide the benefits of bipolar devices over mono-polar devices.

Response to Arguments

Applicant's arguments with respect to claims 31 and 34-36 have been considered but are moot in view of the new ground(s) of rejection. Eggers is presented above in which vaporization of colonic tumors is presented with a return electrode (56). The return electrode is connected to the device's main shaft, therefore it is obvious that it would be positioned within the space in the colon in which a tumor is treated.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

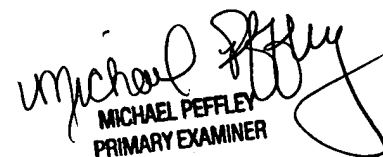
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Vrettakos whose telephone number is 703 605 0215. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on 703 308 0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos
November 22, 2004

PV


MICHAEL PEFFLEY
PRIMARY EXAMINER